

Applicants respectfully assert that one of ordinary skill in the art would not combine the teachings of Kobayashi and Chenevich for at least the following reasons.

As an initial matter, Kobayashi relates generally to an ATM operation supporting system that manages a number of bills in a plurality of ATMs and the system includes a mobile cart, a counting section and a control section. That is, Kobayashi generally relates to an automated system that moves a cart between ATMs to actively manage the number of bills in ATMs.

Further, Chenevich relates generally to a method and system of effecting a payment in response to a payment request where the payment request comprises selecting a payment method from a set of payment methods. That is, Chenevich relates generally to an abstract system for exchanging payments between a payor and a payee. This system appears to be tied to a computer.

The Office Action, on page 3, alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kobayashi in view of the teachings of Chenevich for the basic reason of allowing more than one person to use the system at once or for multiple media actions to be performed at once. Applicants respectfully assert that the obviousness rejection is not supported with a clear and explicit articulation of the reasons why the claimed invention allegedly would have been obvious, including a reasonable rationale as to why prior art references would have been combined or modified. See MPEP §§2141(III) and 2142 citing *KSR*. "Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, quoting *KSR* in turn quoting the Federal Circuit's *In re Kahn* decision with approval. Applicants respectfully assert that the Office Action's assertion that Kobayashi would be modified by Chenevich to allow more than one person to use the system is not rational because there are not, *per se*,

users of Kobayashi's system. As discussed above, Kobayashi's system is effectively a cart which moves between ATMs to redistribute bills.

Further, the Office Action alleges that Kobayashi would be modified by Chenevich so that multiple media actions can be performed at once, citing Chenevich at paragraph [0008] and [0041].

The portion of paragraph [0008] apparently relied upon by the Office Action states "the method may also verify the authorization of the payment requested by seeking payment approval, for example, by communicating payment information to one or more agents of the payor, either in parallel or serially." Applicants respectfully assert that adding parallel communication to Kobayashi would not, in fact, allow multiple payment media actions to occur in parallel because parallel communication would not affect the cart's ability to redistribute bills between ATMs.

Regarding paragraph [0041], the Office Action appears to rely on the statement that "payor 4 could request multiple payments by specifying a single payment method, but specifying multiple payment amounts and multiple payee 6 identities." Applicants respectfully assert that this would not motivate one of ordinary skill in the art to modify Kobayashi's cart to interface with multiple ATMs simultaneously as Kobayashi's invention would require more than one cart to interact with more than one ATM concurrently and specifying multiple payments would not result in multiple carts.

Further, Applicants respectfully assert that it would not have been reasonably predictable to combine Kobayashi and Chenevich. As discussed above, the Office Action proposes to rearrange the parts of Kobayashi and Chenevich without providing a requisite reason why a person of ordinary skill in the art, without the benefit of Applicant's specification, would have rearranged the parts. See MPEP §2144.04 (VI)(C). As discussed

above, Applicants respectfully assert that it would not have been reasonably predictable to combine the mobile cart in Kobayashi with the payment system of Chenevich.

Further, the Office Action, on page 10, argues that Kobayashi teaches (at col. 34, lines 1-11) that the operation of ATMs occur in a parallel manner and that Chenevich teaches that payment information can be communicated to one or more agents of the payer either serially or in parallel. Applicants respectfully assert that the cited portion of Kobayashi merely discloses that two separate ATMs can both perform the same function at the same time. Further, to combine the separate functions of the multiple ATMs would change the principle operation of Kobayashi. Kobayashi teaches moving a cart between ATMs to actively manage the number of bills in multiple ATMs. If the process is moved to a single ATM, then Kobayashi's cart would no longer be necessary and thus the modification of the prior art improperly changes the principle of operation of the prior art. See MPEP §2143.01(VI).

Additionally, the combination of Kobayashi and Chenevich is improper. There was no known, viable reason or means prior the Applicants' invention to combine or modify Kobayashi and Chenevich. Simply, there is no reason to combine Kobayashi's cart with the payment system of Chenevich. As such Applicants respectfully assert that the Office Action proposes to rearrange the parts of Kobayashi and Chenevich to meet the claimed invention without providing the requisite reason why a person of ordinary skill in the art, without the benefit of Applicants' specification, would have rearranged the parts. See MPEP §2144.04(VI)(C).

Consequently, Applicants respectfully assert that the only way in which the Office Action could have combined Kobayashi and Chenevich is through improper hindsight reasoning. Such hindsight reconstruction of the claimed invention is improper. See MPEP §2145(X)(A). There appears to be no logical reason for one of ordinary skill in the art to seek out and combine the teachings of Kobayashi and Chenevich. Applicants assert that, given

circumstances, knowledge gleaned only from Applicants' disclosure was used, which is impermissible hindsight.

Further, even if the combination of Kobayashi and Chenevich were reasonable, which Applicants do not admit, Chenevich fails to teach or suggest performing a payment media action that runs parallel to performance of other payment media actions as alleged on page 3 of the Office Action. Chenevich teaches seeking authorization by communicating payment information in parallel. See Chenevich at paragraph [0008]. Applicants respectfully assert that communicating payment information in parallel is not performing a payment media action in parallel. Claim 1 calls for a payment media operation to include at least one of a payment media acceptance operation, a start fund operation, a payment media change dispensing operation, a payment media advance operation and a bank deposit operation. None of these actions are seeking authorization by communicating payment information in parallel as taught in Chenevich. Therefore the applied references fail to teach or suggest all of the features of independent claim 1.

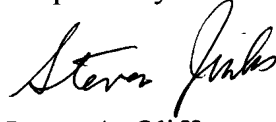
Independent claims 18 and 24 are patentable for the reasons discussed above with respect to independent claim 1.

Claims 2-4, 6-17 and 19 are patentable by reason of their dependency from one of independent claims 1 and 18, as well as for the additional features they recite. It is respectfully requested that the rejection by withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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